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REMARKS

Claims 1-31 are currently pending in the subject application and are presently under consideration. Claims 1, 2, 18, 26 and 29-31 have been amended as shown on pp. 2-7 of the Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

**I. Rejection of Claims 1-16 Under 35 U.S.C. §102(b)**

Claims 1-16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Athing, *et al.* (US 5,987,498 A). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Athing, *et al.* does not teach or suggest each and every limitation of applicant's claimed invention.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The subject invention relates to providing user and device specific configuration to a portable communications device. The applicant's claimed invention receives, stores, and transmits configuration information that is associated with a user, device, and configuration settings of the device. In doing so, the device can be configured with a configuration that meets the needs of the device user under a certain circumstance and can be configured differently to meet the needs of the same user under alternate circumstances. This includes have alternate configurations for the user for the same configurable setting of the device. This also allows for the one or more devices to have specific configurations for each of a plurality of users. In particular claim 1 recites *a first configuration file for a user containing a first value for at least one configurable setting of the communications device and a second configuration file for the*

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*user containing a second value for the at least one configurable setting of the communications device.*

Athing, *et al.* does not teach or suggest the aforementioned novel aspects of applicant's invention as recited in the subject claim. The cited reference teaches a system for viewing e-mail on a local computer that has been aggregated on a remote server from multiple e-mail systems. The system allows the user to specify display preferences for the e-mail, however, the display preferences are the same for any local computer the user employs. Furthermore, the system of Athing, *et al.* does not teach or suggest that the user can maintain multiple configurations of the same configurable setting for the same device as taught in the applicant's claims invention. Therefore, Athing, *et al.* fails to teach or suggest *a first configuration file for a user containing a first value for at least one configurable setting of the communications device and a second configuration file for the user containing a second value for the at least one configurable setting of the communications device.*

Moreover, claim 15 (and similarly claim 16) recites *the configuration response message enables the communications device to be updated with at least one application and associated setting.* The subject invention is capable of employing the response message to download applications and configuration settings for the applications to enable a user to have one set of applications on the portable communications device in one usage environment and another set of applications during another usage environment. Athing, *et al.* is silent regarding downloading applications and therefore does not teach or suggest the novel features of the subject claims.

In view of at least the foregoing, applicant's representative respectfully submits that Athing, *et al.* fails to teach or suggest all limitations of applicant's invention as recited in independent claim 1 (and claims 2-16 that depends there from), and thus fails to anticipate the claimed invention. Therefore, this rejection should be withdrawn.

## **II. Rejection of Claim 17 Under 35 U.S.C. §103(a)**

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Athing, *et al.* (US 5,987,498 A) as applied to claims 1-16 above, and further in view of Aho, *et al.* (US 6,198,941 B1). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Athing, *et al.* and Aho, *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicant's claimed invention.

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To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 17 depends from independent claim 1. Aho, *et al.* fails to cure the above noted deficiencies of Athing, *et al.* with respect to independent claim 1. Aho *et al.* fails to teach or suggest any type of user based configurability. Rather, Aho *et al.* describes monitoring indicators of a communication signal and making changes to the transport and/or application protocol layer to support a transition to a different communication arrangement if the communication signal indicators indicate that a change in communication arrangement is eminent. These changes are not based on any user specific configurations. Therefore, Aho *et al.* fails to teach or suggest *a first configuration file for a user containing a first value for at least one configurable setting of the communications device and a second configuration file for the user containing a second value for the at least one configurable setting of the communications device* as recited in claim 1.

Accordingly, withdrawal of this rejection is respectfully requested.

### III. Rejection of Claims 18-31 Under 35 U.S.C. §103(a)

Claims 18-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Athing (US 5,987,498 A) in view of Martin, Jr. *et al.* (US 6,509,913 B2). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Athing, *et al.* and Martin, Jr. *et al.*, alone or in combination, do not teach or suggest each and every limitation of applicant's claimed invention.

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Independent claim 18 (and similarly independent claims 26, 29, and 31) recites *storing a first configuration file for a user containing a first value for at least one configurable setting of a communications device, and a second configuration file for the user containing a second value for the at least one configurable setting of the communications device*. As discussed *supra* with respect to independent claim 1, Athing, *et al.* fails to teach or suggest these novel features of the subject claims. Furthermore, Martin, Jr. *et al.* fails to make up for the deficiencies of Athing, *et al.* with respect to these claimed features. Martin, Jr. *et al.* discloses a system for providing a configurable user interface on a portable device. In particular, the cited prior art provides for configurability that can be specific to the device and the user of the device, thereby allowing the user to have a different configuration for each device they use. However, the cited reference fails to teach or suggest the a user can have multiple configurations for the same device as recited in the subject claims. Therefore, Martin, Jr. *et al.* fails to teach or suggest *a first value for at least one configurable setting of a communications device, and a second configuration file for the user containing a second value for the at least one configurable setting of the communications device*.

In view of at least the above, it is respectfully submitted that Athing, *et al.* and Martin, Jr. *et al.*, alone or in combination, fail to teach or suggest all aspects of applicant's invention as recited in independent claims 18, 26, 29 and 31 (and claims 19-25, 27, 28 and 30 that depend there from), and thus fails to make obvious the subject claimed invention. Consequently, this rejection should be withdrawn.

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CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [TELNP221USA].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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